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09/772,601	01/30/2001	Thomas W. Poplawski	P/2167-247	1711
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HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109			FELTEN, DANIEL S	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/772,601  
Filing Date: January 30, 2001  
Appellant(s): POPLAWSKI ET AL.

**MAILED**

**JUN 20 2006**

**GROUP 3600**

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Ce Li  
(Reg. No. L0214)  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed February 13, 2006 appealing from the Office action  
mailed November 17, 2004

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The amendment after final rejection filed on September 13, 2005 has been entered.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Haseltine et al (US 6,578,015); and Hogan (US 5,599,528).

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC # 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-9, 17-19, 24-26 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haseltine et al (US 6,578,015) in view of Hogan (US 5,599,528).

Re Claim 1:

--Haseltine discloses a method for effectuating bill presentment and payment comprising: maintaining a billing database (400), the billing database (400) containing detailed billing information (402, 404) with respect to at least one bill, the at least one bill reflecting an account of at least one payer with respect to at least one biller (see Haseltine, Abstract', col. 5, 11. 12-18);

--generating an electronic summary (402) of the at least one bill using the detailed billing information, the electronic summary being formatted in the form of a remittance slip traditional paper bill that would be traditionally associated with a paper based bill (see Haseltine, col. 5, 11. 12-18+);

--generating an electronic notification with respect to the at least one bill, the electronic notification containing the electronic summary and an address through which the billing database may be accessed (see Haseltine, col. 7, 11. 34-47). and transmitting the electronic notification to the at least payer, (see Haseltine, col. 7, 11. 34-47),

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--Haseltine fails to disclose wherein the electronic summary can be printed out to serve as a the remittance slip in a traditional method of payment of the at least one bill by the at least one payers whereby the at least one payer retains control of the bill payment process by the traditional method.

--Hogan discloses a method for bill delivery and payment over the Internet wherein the electronic summary/bill can be printed out to serve as a the remittance slip in a traditional method of payment of the at least one bill by the at least one payers whereby the at least one payer retains control of the bill payment process by the traditional method (see Hogan, Abstract; and col. 5, 11. 1-15). *The ability to print text and images from an Internet website that is displayed on a computer screen is notoriously old and well known with the computer networking art. Thus to modify Haseltine with the ability to print personal billing information from an Internet website, as taught by Hogan, would be considered an obvious expedient well within the ordinary skill in the art because an artisan would recognize the fact that users may prefer/require printed copies as backup of their electronic files in the event that the electronic file(s) and/or database becomes corrupted, compromised and/or lost.*

--Thus an artisan of ordinary skill in the art at the time of the invention would have been motivated to modify Haseltine with Hogan's teachings to have an alternative to viewing the bills and so that the users can feel more secure with using an online billing/payment system. Thus such a convenience would have been an obvious expedient well within the ordinary skill in the art.

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Re claim 2:

Haseltine discloses maintaining an Internet site, wherein the billing database containing the detailed billing information is maintained on the Internet site (see Haseltine, col. 9, ll. 51 +).

Re claim 3:

Haseltine discloses wherein the Internet site is maintained by the at least one biller (see Haseltine, col. 9, ll. 51+).

Re claim 6:

Haseltine discloses wherein address through which the billing database may be accessed is a Uniform Resource Locator (URL) address of the Internet site, the method further comprising:

--providing the at least one payer with access to the Internet site through the URL;  
and authenticating the at least one payer at the Internet site (see Haseltine, col. 11, ll. 5-30).

Re claim 7:

Haseltine discloses allowing the at least one payer with the opportunity to pay the bill electronically on the Internet site (see Haseltine, col. 10, ll. 5-11).

Re claim 8:

Haseltine discloses wherein the electronic notification is an e-mail message (see Haseltine, col. 7, ll. 34-47).

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Re claim 9:

Haseltine the at least one payer to enter a unique username and password (see Haseltine, col. 9, discloses wherein the step of authenticating the at least one payer requiring 11. 16+).

Re claim 17:

Haseltine discloses wherein the electronic summary information contains at least a name of the at least one biller, a statement date, a minimum amount due, a total amount due and a due date (see Haseltine, col. 8, ll. 8+).

Re claim 18:

Haseltine discloses registering the at least one payer with the at least one biller with respect to receiving the electronic notification of the present invention (Haseltine, col. 7, ll. +).

Re claim 19:

Haseltine discloses a method for effectuating electronic bill presentment and payment comprising the steps of:

maintaining a billing database the billing database continuing detailed billing information with respect to at least one payer of the at least one biller (see Haseltine, Abstract; col. 5, 11. 12-18). maintaining an electronic site wherein the at least one payer can view the electronic site, the electronic site containing a display of the detailed billing information (see col. 9, 11. 51 +); authenticating the at least one payer before allowing the at least one payer access to the display of detailed billing information (see Haseltine, col. 9, 11. 16+), generating an e-mail continuing

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summary information regarding a bill owed by the at least one payer to the at least one biller which is formatted as a remittance slip that would be traditionally associated with a paper based bill (see Haseltine, col. 7, 11. 34-47) ; and transmitting the e-mail to the payer wherein the summary information can be printed out to serve as the remittance slip in a traditional method of payment of the bill by the at least one payers whereby the at least one payer retains control of the bill payment process by the traditional method (see explanation for claim 1 in view of Hogan).

Haseltine fails to disclose registering at least one biller with a service provider. Hogan discloses registering at least one biller with a service provider (electronic bill service company, "88SC") (see Hogan, col. 4, 11. 36+; and col. 5, 11. 44+)

It would have been obvious for one of ordinary skill in the art at the time the invention was made to

Re claim 24:

Haseltine discloses a system for effectuating bill presentment and payment, the system comprising; a billing database (400), the billing database continuing detailed billing information with respect to at least one bill, the at least one bill reflecting an account of at least one payer with respect to at least one biller (see Haseltine, Abstract; col. 5, 11. 12-18);

a processor (702 with logic--v3o) coupled to the billing database, the processor (see Haseltine, figs. 6, 7, col. 11 . 11. 63 to col. 13, 11. 40):

generating an electronic summary of the at least one bill using detailed billing information, the electronic summary being formatted in the form of a remittance slip that would be traditionally associated with a paper based bill, generating an electronic notification



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containing the electronic summary and containing an address through which the billing database may be accessed; and a communication network coupled to the processor, the processor transmitting the electronic notification to the at least payer over the communication network, wherein the electronic summary can be printed out to serve as the remittance slip in a traditional method of payment of the at least one bill by the at least one payer. whereby the at least one payer retains control of the bill payment process by the traditional method.

Re claim 25:

(see citation for claim 2)

Re claim 26:

(see citation for claim 3)

Re claim 29:

(see citation for claim 6)

Re claim 30:

(see citation for claim 7)

Re claim 31:

(see citation for claim 8)

Re claim 32:

(see citation for claim 9)

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5. unpatentable over Haseltine et al (US 6,578,015) as modified by Hogan (US 5,599, 528) as applied to claim 1 as discussed above, and further in view of Schutzer (US Claims 4, 5, 10-16, 20-23, 27 and 28 rejected under 35 U.S.C. 103(a) as being (US6,292,789) and Hilt et al (US 5,465,206). The teachings of Haseltine as modified by Hogan have been discussed above.

Re claims 4, 5, 14, 20, 21, 27, 28:

Haseltine as modified by Hogan fail to teach of fairly suggest, as wherein the Internet site is maintained by a Billing Service Provider (BSP) the BSP performing billing services for the at least one biller; and as in claim 5, wherein the Internet site is maintained by a Customer Service Provider (CSP) the CSP performing billing services for the at least one biller.

Schutzer discloses wherein the Internet site is maintained by a Billing Service Provider (BSP) the BSP performing billing services for the at least one biller (see Schutzer, fig. 7, col. 11, ll. 33-64); as in claim 5, wherein the Internet site is maintained by a Customer Service Provider (CSP) the CSP performing billing services for the at least one biller (see Schutzer, fig. 7, col. 11, ll. 33-64 and col. 14, ll. 26+).

In view of Schutzer, it would have been obvious for an artisan at the time of the invention was made to employ the teachings of Schutzer to the teachings of Haseltine as modified by Hogan because an artisan at the time of the invention would recognize the features disclosed in Schutzer were an obvious extension of the electronic bill service company ("EBSC") disclosed in Hogan for the motivations enunciated by Hogan (see col. 4, ll. 3673). Thus such a

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modification would have been considered substitution of functional equivalence and/or providing the latest technology in the bill presentment art.

Thus such a modification would have been considered an obvious expedient well within the ordinary skill in the art.

Re claim 10:

registering the at least one biller with a billing service provider (BSP), wherein the BSP interfaces with the at least one biller with respect to the presentment of the at least one bill; and registering the at least one payer with a customer service provider (CSP), wherein the CSP interfaces with the at least one payer with respect to the payment of the at least one bill (see Schutzer, figs. 8 and col. 15, ll. 39 to col. 16, ll. 44).

Re claims 11, 12, 13, 22, 23:

Haseltine as modified by Hogan fail to teach of fairly suggest wherein the BSP and CSP are the same entity', wherein the BSP and/or the CSP is a bank. Hilt teaches that the BSP and CSP are the same entity and wherein the BSP and/or the CSP is a bank (16 and 18) (see Hilt, figs. 4, 6, 7, Abstract. col. 12, ll. 41 +; col. 16, ll. 4+; and col. 17, ll. 46+). The motivation to combine the Hilt reference with Haseltine, Hogan and Schutzer would be to overcome shortcomings in the prior art expressed by Hogan in the prior art (see figs. 1-3, starting in col. 4, ll. 7 to col. 10, ll. 29) wherein Haseltine, Hogan and

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Schutzer are presented as various systems within the Electronic Bill Payment and presentment art. Thus such a modification would constitute an obvious expedient well within the ordinary skill in the art.

Re claim 15:

wherein the step of transmitting the detailed billing information further comprises:

--transmitting the detailed billing information as a bulk file containing all of the detailed billing information for a specified period of time (see Haseltine, Abstract; col. 5, ll. 12-18).

Re claim 16:

wherein the specified period of time is one month (see Haseltine, Abstract; col. 5, ll. 12-18).

#### **(10) Response to Argument**

References are evaluated by what they suggest to one versed in the art, rather than their specific disclosure (see *In re Bozek*, 163 USPQ 545 (CCPA 1969)). In this case, the primary reference, Haseltine discloses a method for effectuating bill presentment and payment generating a electronic summary (402) of at least one bill using the detailed billing information, the electronic summary formatted in the form of a remittance slip (traditional paper bill) that would be traditionally associated with a paper based bill (see Haseltine, col. 5, ll. 12+), the secondary reference, Hogan, shows billing data that is stored in such a form that it allows billing data to be viewed on PC and printed on printers (see Hogan, col. 5, ll. 1-15). The 35 USC 103 rejection

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set forth above provide reasoning for the combinations of references and resolve the level of ordinary skill in the art business art. The examiner respectfully submits that the applicant has applied a more stringent standard to the reference than the limitations of the claims. This is a reversal of their appropriate roles, as the reference is used as a whole as a teaching in light of the level of skill in the art.

Moreover the applicant cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combination of references. Specifically, applicant discusses that Haseltine fails to disclose that the electronic summary can be printed out to serve as a remittance slip in a traditional method payment and states that the reference teaches away from the claimed invention. These deficiencies of the reference were addressed in the Office Action dated November 4, 2004 wherein it states that *"The ability to print text and images from an Internet website that is displayed on a computer screen is notoriously old and well known with the computer networking art. Thus to modify Haseltine with the ability to print personal billing information from an Internet website, as taught by Hogan, would be considered an obvious expedient well within the ordinary skill in the art because an artisan would recognize the fact that users may prefer/require printed copies as backup of their electronic files in the event that the electronic files) and/or database becomes corrupted, compromised and/or lost."*

In the interpretation of the examiner, the applicant has over-simplified the issue by suggesting that the background of Haseltine simply does not show a remittance slip. It is agreed that the exact words "remittance slip" are not used, but as the Background of Haseltine suggests, it is conventionally accepted that a form of remittance data is inherently issued as part of a paper bill when a bill is mailed to the payee and sent from the payee to the biller. Although Haseltine

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and Hogan talk primarily about “the bill”, it is suggested in Haseltine that the “look and feel” of the electronic bill comes from an actual paper bill. The examiner interprets the “look” of a traditional paper bill to inherently include a form of remittance information. Thus the examiner argues that Haseltine suggests a electronic remittance slip, being inherently conjoined data to the electronic bill.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

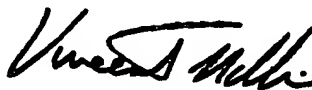
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